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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/963,246	Applicant(s) DAUGHERTY ET AL.	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/17/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the paper(s) filed 5/29/2009.

37 CFR 1.132 Declaration

1. A declaration made by Daniel Fossner signed 5/28/2009 and filed 5/29/2009 is ineffective to overcome Chamberlain as prior art and is ineffective to overcome the previous rejections relying on Chamberlain for the following reasons.

- The declaration is one made as a 37 CFR 1.132 declaration rather than a proper 37 CFR 1.131 declaration. See MPEP 715.01.
- A declaration under 37 CFR 1.131 to swear behind a reference must be signed by applicant(s). The assignee may sign when it is not possible to produce the declaration of the inventor. There is no evidence that this is the case. See MPEP 715.04.
- It is argued that page 1 of exhibit 1 shows conception on or before 8/31/2000. However the document itself is clearly more recent because there are newer revisions listed and because said page 1 also includes a "last modified" date of 9/12/2000. Further, the document "One-Click Details" forming part of exhibit 2 is dated as 9/14/2000 - also after the effective date of Chamberlain.
- Further there is no explanation regarding which portions of this evidence relates to each and every claimed feature for all claims.
 - MPEP 715.07 I: "The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a

general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Chamberlain reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Chamberlain reference to either a constructive reduction to practice or an actual reduction to practice. There is mention of an email to a patent attorney on 9/19/2000, but no other activity between 9/8/2000 and 9/19/2000 is noted nor is the lack of activity explained. See MPEP 715.07(a).

4. The declaration of Daniel Fossner additionally raises the following questions:

- Daniel Fossner declares he created the document filed as exhibit 1. Is he therefore an inventor? What about the other people involved listed on page 1

- of 8? What about Donald Robinson who apparently created the mock-up figure on page 8 of 8 – the same figure that was filed with the applications?
- Applicant need not respond to these questions if the inventorship is correct as filed.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-17, 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. Examiner recommends including language that specifies a programmed computer is responsible

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for carrying out the method steps (i.e. not merely a nominal recitation of a computer accepting input or performing output, but rather a computer performing the essential calculations, determinations, algorithms, etc.).

Claim Rejections - 35 USC § 102 and 103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-10, 12, 17, 19, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chamberlain (US20030208369).**

Chamberlain includes benefit to provisional US application 60/231298 (filed 9/8/2000) and cited/included in a previous action. This action will refer to the disclosure as it appears in the 60/231298 provisional.

Regarding claims 1, 2, 4, 5, 9, 12, 17, 19, 20, Chamberlain teaches a website including a banner advertisement that includes user selectable fields. Each field is associated with an information delivery channel. The user may select email, FAX, mail, phone, etc. The user selects this field, provides his contact information (i.e. consents to information receipt at the indicated location) and the business will then provide further information about the advertisement/product over this channel to the requesting consumer [page 1 of provisional, figs 5, 8 of provisional]. Regarding the claim language concerning the sign-in procedure, Chamberlain teaches that the user may enter his channel-contact information each time he makes a request for information, or his contact-channel information can be part of a stored profile located at the server [provisional's page 7 middle paragraph, pg 9 lines 15-17, figure 7 (option 3)]. In this manner, the user does not have to continually type his various contact information (although he still can). It is taken to be inherent that in order for the system to access the proper stored profile for that particular user, the server would have to identify and authenticate that particular user according to some sign-in process. This then enables the user to specify a stored contact-channel delivery preference for that particular advertisement under consideration. Alternatively, it would have been obvious to one of ordinary skill at the time of the invention to have

provided any well known sign-in procedure to identify and authenticate the user so that Chamberlain's server-store user profiles can be properly accessed.

Regarding claim 3, the information delivered provides an indication of the personal information used by way of the channel that the consumer gets the information.

Regarding claims 6-8, 10, providing a parcel/letter to the US Postal Service for example for delivery to the identified recipient is taken to be providing a third party with the personal/contact information of the consumer as well as an indication of the consumer's choice to have a postal delivery for them at that location.

Claims 11, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chamberlain in view of Patterson (US2003/0028608).

Regarding claims 11, 14-16, Patterson also teaches a user of a webpage filling out a text field with contact information so that the business who is advertising can contact that consumer through the specified communication channel and unique communication address provided [para 0026]. Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a confirmation notice that the information will be provided via the communication channel, such as for example by third party US Postal Service.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.

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[NOTE: the following is a repeat of previous rejections as alternative rejections]

10. Claims 1-10, 12, 17, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg (US6330243).

Regarding claims 1, 2, 4, 17, 19, 20, Stranberg teaches that it is well known for consumers to request product information from a business via the World Wide Web and for the business to provide a field for the inquiring party to provide a telephone number where they can be contacted for further information and follow-up [col 1: lines 28-46]. Stranberg also teaches the concept of a user accessing a webpage from a website via a web browser where the webpage can include various content such as text, images, audio, video, etc. as well as an HTML-based user interface with data entry capability. The HTML interface serves to advertise that more information about a product/service is available upon request and is therefore taken to meet the broad term "advertisement" as well as the term "item" [col 5: lines 7-8, lines 16-35]. The data entry fields of the interface are designed to elicit responses to requests for product information as is well known in the art" [5:24-26]. Such requests can include name, telephone, address, information desired, product inquiries or any other information useful for sales and/or marketing purposes [5:27-31]. While Stranberg admits it is known to contact an inquiring consumer via a submitted telephone number in order to provide the requested product information,

Stranberg is silent on whether to contact the inquiring consumer according to the other collected information fields such as address. However, It would have been obvious to one of ordinary skill at the time of the invention to have provided any number of plural contact field options (postal mail, FAX, telephone, cell phone, email, etc. as they are well known methods of communication – and in some cases, *electronic* communication), to have collected the appropriate number, address, email, etc. and to have contacted the inquiring party by such requested communication channels in order to deliver the desired product information. Doing so would allow consumers to receive the requested information in a format they find most comfortable, digestible and convenient – including an *electronic* delivery transmission method. Each of the plural fillable fields of Stranberg's interface is taken to represent a "selectable" option. Regarding the claim language concerning the sign-in procedure, Strandberg teaches that the system includes a user database [7:34] and that the system logs all of the information exchanged [8:33-35] and that the user database can store user name, address, telephone; and the system allows a record of those users who inquired further about their products or services [8:36-45]. It is taken to be inherent that in order for the system to access the proper user record in the database, the server would have to identify and authenticate that particular user according to some sign-in process. Alternatively, it would have been obvious to one of ordinary skill at the time of the invention to have provided any well known sign-in procedure to identify and authenticate the user so that the proper user record in the user database can be accessed.

Regarding claim 3, receiving a FAX, email, telephone call, postal mailing, etc inherently represents receiving an indication of personal information used to make such communication contact.

Regarding claims 5, 9, any of the received information about the consumer is taken to be personal information.

Regarding claims 6-8, 10, providing a parcel/letter to the US Postal Service for example for delivery to the identified recipient is taken to be providing a third party with the personal/contact information of the consumer as well as an indication of the consumer's choice to have a postal delivery for them.

Regarding claim 12, it would have been obvious to one of ordinary skill at the time of the invention to have asked for consent to send future communications to the consumer in order to deliver future promotional materials as is well known. Doing so would serve to create a long-term relationship with the consumer.

11. Claims 11, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg as above and further in view of Patterson (US2003/0028608).

Regarding claims 11, 14-16, Patterson also teaches a user of a webpage filling out a text field with contact information so that the business who is advertising can contact that consumer through the specified communication channel and unique communication address provided [para 0026]. Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028]. It would have been obvious to one of ordinary skill at the time

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of the invention to have provided a confirmation notice that the information will be provided via the communication channel, such as for example by third party US Postal Service.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.

12. Claims 6, 10, 11, 13-16 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg in view of Patterson as above and/or over Patterson in view of Stranberg.

Regarding claims 6, 10, Patterson teaches that a consumer (i.e. first party) can visit a first website (i.e. second party) which can include not only content about the first business, but also a banner advertisement from a second business (i.e. third party). The advertisement is taught to include a request form that the user can fill out such as "send me information on golf clubs" [para 0026]. The form can collect the user's email address as contact information as well as userID [para 0037]. It would have been obvious to one of ordinary skill at the time of the invention to have provided the plurality of contact options in a manner made obvious by Stranberg with the third party advertisement of Patterson. Doing so would enable web surfers at many various websites to see and request the product information of Stranberg; this provides wider exposure for the third party. A consumer filling out a particular selectable option with his personal contact information results in an indication to the third party of the consumer's desire for information and the requested delivery channel and would trigger the delivery

of such information via the proper communication channel (email, telephone, FAX, postal mail, etc.).

Regarding claims 11, 14-16, Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028, figure 4]. This message serves to indicate that the third party will be delivering the requested information.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.

Response to Arguments

Applicant argues that Chamberlain is not prior art. This is insufficient for at least the reasons given above.

Applicant argues that Strandberg is not related to advertisements. Examiner disagrees because Strandberg teaches soliciting for users to request more product information. These are advertisements for and about the product.

Applicant argues that Strandberg fails to teach a selectable option. Examiner firmly believes that one of ordinary skill would recognize a fillable field as a means for a customer to select how he can be contacted for more information about a product. Receipt of this information provides not only the information but provide an indication that a selection was made by the consumer.

Applicant seemingly argues the date that examiner applied a reference as being somehow an indication of hindsight. Examiner disagrees. The rejection is made as to

what would have been obvious *at the time of the invention*. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

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Primary Examiner
Art Unit 3622